IFW 3634

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

PER SOLSØ HINDHEDE et al.

Docket No.: IPB.016

Serial No.: 10/542,979

Group Art Unit: 3634

Filed: June 21, 2005

Examiner: Russell F. Bloodgood

For: A VENETIAN BLIND

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ELECTION

In response to the Office Action dated May 18, 2007, the applicants point out that the present application is a PCT nationalization filed under 35 U.S.C 371. The applicants also point out that the International Searching Authority did not find any unity of invention problem with the present application. Furthermore, PCT Article 27(1) provides:

> Article 27
> National Requirements
>
> (1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

In view of PCT Article 27(1), since the International Searching Authority did not find any unity of invention problem with the present application, the Examiner should not impose additional requirements relating to unity of invention.

Furthermore, even if the Examiner had been correct in imposing additional requirements relating to unity of invention, the Examiner applied the wrong standard to the present application with respect to the issue of a single invention. The Examiner has applied the standard of MPEP 806.05 and, more specifically, MPEP 806.05(h). The heading of MPEP 806.05 is "806.05 Related Inventions [R-5] - 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting". Furthermore, the heading and first section of MPEP Chapter 800 follows:

> "801 Introduction - 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting
>
> 801 Introduction
>
> This chapter is limited to a discussion of the subject of restriction and double patenting under Title 35 of the United States Code and Title 37 of the Code of Federal Regulations as it relates to national applications filed under 35 U.S.C. 111(a). The discussion of unity of invention under the Patent Cooperation Treaty Articles and Rules as it is applied as an International Searching Authority, International Preliminary Examining Authority, and in applications entering the National Stage under 35 U.S.C. 371 as a Designated or Elected Office in the U.S. Patent and Trademark Office is covered in Chapter 1800."

It is clear that these sections apply to applications filed under 35 U.S.C. 111, not to the present application, which was not filed under 35 U.S.C. 111, but rather was filed under 35 U.S.C. 371 as a PCT nationalization.

MPEP 1893.03(d) makes clear that Unity of Invention standards apply to nationalizations of PCT applications and, therefore, to the present application:

> "1893.03(d) Unity of Invention [R-3] - 1800 Patent Cooperation Treaty
>
> 1893.03(d) Unity of Invention [R-3]

37 CFR 1.499 Unity of invention during the national stage

> If the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144."

However, the International Searching Authority did not find any unity of invention problem with the present application, and, therefore, in accordance with PCT Article 27(1), the Examiner should not make a unity of invention requirement.

Furthermore, the present claims satisfy unity of invention requirements. 37 CFR 1.475(b) states: "An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: ... (2) A product and process of use of said product". Claim 11 is a process of use (a method for mounting) of the product (the Venetian blind) of claim 1.

Moreover, even if it were proper for the Examiner to make an additional requirement concerning unity of invention after the International Searching Authority did not find any unity of invention problem with the present application, and even if the restriction requirement standards of MPEP 806.05(h) for an application that is not a PCT nationalization were applied, the method as claimed can NOT be practiced with another, materially different blind, because the method of claim 11 specifies that the blind is the blind of claim 1. The standards of MPEP 806.05(h) are based on the invention as claimed. Therefore, since the method of claim 11

specifies that the blind is the blind of claim 1, the method as claimed can NOT be practiced with a blind that is materially different from the blind as claimed.

The applicants hereby elect, with traverse, the Group I claims, claims 1-10.

Examination and allowance of all of the claims is respectfully requested.

Respectfully submitted,

Date: 6-4-07

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